

Appl. No. 10/730,438
Docket No. CM2713Q
Response dated March 4, 2009
Reply to Office Action mailed on November 25, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 1-11 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 is amended. Support for the amendment is found in the specification at page 7, lines 16-18. No new matter is believed to have been added, and entry of the claims as amended is respectfully requested.

Claims 1-11 currently stand rejected.

Rejections Under 35 U.S.C. §103

Claims 1-7, 10 and 11 stand rejected under 35 U.S.C. §103(a) as unpatentable over McCormack et al. (USPN 6,719,742) in view of Polansky et al. (USPN 4,249,532).

Claims 8 and 9 stand rejected under 35 U.S.C. §103(a) as unpatentable over McCormack et al. (USPN 6,719,742) in view of Polansky et al. (USPN 4,249,532) and further in view of McFarland et al. (USPN 6,096,412).

Applicants respectfully traverse the rejections.

Interview

Applicants thank the Examiner for the courtesy of the telephone interview held with the undersigned on March 4, 2009. Applicants believe that the interview served to clarify issues.

Requirements for *Prima Facie* Conclusion of Obviousness

1. Claimed Invention As A Whole Must Be Considered.

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been

Appl. No. 10/730,438
Docket No. CM2713Q
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Customer No. 27752

obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q. 871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the Applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

2. *All Claim Elements Must Be Taught Or Suggested By Prior Art.*

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

3. *A Teaching, Motivation or Suggestion to Combine the Cited References Must be Found in the Prior Art.*

[A] patent [claim] composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007). Although the Supreme Court in *KSR* rejected rigid application of a rule requiring demonstration of a teaching, motivation or suggestion within prior art references to combine them as a basis for a conclusion of obviousness, it did not abrogate the requirement. Rather, recognizing that the TSM requirement captured a “helpful insight,” the Court suggested its approval of the TSM analysis within a flexible approach. *See id.* at 1741, 1743. Accordingly, the Federal Circuit has subsequently stated:

[A] flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence

Appl. No. 10/730,438
Docket No. CM2713Q
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Customer No. 27752

before the time of invention."). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence—teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)—that arise before the time of invention as the statute requires. As KSR requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs., Inc., 520 F.3d 1358, 1364-1365; 86 U.S.P.Q.2D 1196 (Fed. Cir. 2008) (judgment of nonobviousness and infringement affirmed).

. . . There is no suggestion to combine [references] . . . if a reference teaches away from its combination with another source. *See id.* at 1075, 5 U.S.P.Q.2D (BNA) at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1359-1360; 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230 U.S.P.Q. 416 (Fed. Cir. 1986), *quoting In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

Appl. No. 10/730,438
Docket No. CM2713Q
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Customer No. 27752

Analysis

Applicants respectfully submit that application of the rules of decision set forth above to Applicant's claims and the cited prior art references compel the conclusion that a *prima facie* case of obviousness of the claims as amended is not supported.

Applicants' Claim 1 recites a disposable article comprising, *inter alia*, a backsheet, wherein the backsheet comprises at least one polymeric film and at least one nonwoven web formed of fibers, wherein the polymeric film is joined in an overlaying region to at least part of the nonwoven web to form the backsheet, and wherein the backsheet in the overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an "a" value for red/green-appearance from about -50.0 to about +50.0 and a "b" value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs. By dependency, all remaining claims include these elements.

The Office Action dated 11/25/08, at page 4, top, states that McCormack et al. teaches or suggests a backsheet which, in an overlaying region and in areas outside printed designs, has an L Hunter value falling within the ranges set forth in Applicants' claims. For the following reasons Applicants respectfully submit that McCormack et al. does not teach or suggest these particular elements of Claim 1 as amended, and request reconsideration.

McCormack et al. teaches examples of a film layer component of a laminate that have reported L* values of, *e.g.*, 74.85, 73.86, 74.58, and 73.476. (Cols. 19 and 20, Table 1 (Examples 1 and 4.) Assuming, *arguendo*, that the L*a*b* color scale used by McCormack et al. is equivalent to the Hunter scale of Applicants' claims, these values fall within the Hunter L range (10 to 75) of Applicants' claims. However, the reported values of the examples are given, not for a *backsheet comprising a film and a nonwoven formed of fibers* as recited by Applicant's Claim 1, but rather, for a *film alone*. No L* value falling within the range (10 to 75) is taught or suggested for a *backsheet comprising*

Appl. No. 10/730,438
Docket No. CM2713Q
Response dated March 4, 2009
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Customer No. 27752

a film and a nonwoven, i.e., a composite backsheet comprising component layers of film and nonwoven.

Neither of the other references cited, Polansky et al. and McFarland et al., disclose the elements of Applicant's Claim 1 missing from McCormack et al.

Additionally, McCormack et al. strongly suggests that a composite backsheet having values falling within the range of Applicants' claims would be undesirable. McCormack et al. states:

[T]he films of the present invention allow for thin films with good color-contrast in the embossed regions without requiring a deeply colored film *that substantially darkens or adulterates the lighter color of adjacent layers*. Accordingly, when a first layer is desired having a light appearance (e.g. white, off-white and so forth) it is desirable that the underlying second colored layer have an L* number not less than about 70, *and still more desirably an L* number not less than about 85*. This *color problem* can be further improved by employing a more opaque top sheet, a brighter top sheet, an opaque or dark backing layer that has low light reflectance and/or a first layer containing optical brighteners.

McCormack et al., Col. 6, lines 27-39. Thus, McCormack et al. suggests that darkening a sheet laminate by including a component *film layer* having an L* value of less than 70 is undesirable, indeed, can cause a "color problem". To mitigate the "color problem," McCormack et al. teaches that it is desirable that the *colored film layer component* have an L* value not less than about 85.

Consistent with this suggestion in McCormack et al., in other prior art cited by the Office in a previous Office Action (Office Action dated 4/23/08), it was taught that providing a high degree of whiteness of a diaper was desirable for purposes of consumer acceptance. *See* Tao et al. (WO 99/32164) page 2, lines 23-35) ("It has . . . been found that a high degree of whiteness, i.e., the visual appearance of the white color of the article as seen by the consumer, is very important to the consumer. Consumers tend not to accept articles that incorporate films having a yellowish or off-white shade.")

In summary, the combination of McCormack et al., Polansky et al. and McFarland et al. does not support a *prima facie* conclusion of obviousness of Applicants' Claim 1, nor of the remaining dependent claims, for the following reasons:

Appl. No. 10/730,438
Docket No. CM2713Q
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Customer No. 27752


- * The combination does not teach or suggest a *backsheet*, wherein the backsheet comprises at least one polymeric film and at least one nonwoven web formed of fibers, wherein the polymeric film is joined in an overlaying region to at least part of the nonwoven web to form the backsheet, and wherein the backsheet in the overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, in the areas outside printed ornamental designs; and
- * McCormack et al. teaches away from a *backsheet* having an L Hunter value within the range of Claim 1, and therefore, cannot provide a basis for a conclusion of obviousness.

Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, reconsideration of this application and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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